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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of  
Douglas D. DeMasi, Sr.  
SN 09/845,999  
Filed: 9/24/2001  
For "Universal Flying Hawk"

: Art Unit 3714  
: Examiner Miller, Bena B.

8 Scenic Drive; Hagan Farms  
Poughkeepsie, NY 12603-5521  
January 24, 2009

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Mail Stop Appeal Brief - Patents

APPEAL BRIEF

Sir:

Appellant hereby files in triplicate a Brief in support of the Notice of Appeal to the Board of Appeals and Interferences dated December 8, 2008 and filed December 11, 2008, on the Examiner's Final Rejections of claims 21-42 and 44-51 in the Office Action mailed 9/18/08; and on the Examiner's refusal, per the Advisory Action mailed 11/6/08, to enter the amendments proposed in the Amendment After Final dated October 23, 2008 and filed October 27, 2008 and allow the application.

The Amendment After Final dated October 23, 2008 and filed October 23, 2008, stands not entered because the Examiner in the Advisory Action mailed 11/6/08 thought that the proposed amendments filed after a final rejection "raise new issues that would require further consideration and/or search; \_\_\_\_\_. The amendment to the claims, specifically claims 21, 28, 34, 38 and 44 raise new issues that would require further consideration and /or search."

The Examiner also said that "The request for reconsideration has been considered but does NOT place the application in condition for allowance because: The remarks filed on 10/27/08 are not convincing. Therefore, the examiner has maintained the Final rejection."

Attached is the \$270 fee set forth in 37 CFR section 41.20(b)(2).

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There follows the items under appropriate headings and in the order indicated in paragraph (c)(1)(i) through (c)(1)(x) of section 41.37 "Appeal Brief" of Title 37 CFR Patents, Trademarks, and Copyrights:

(i) Real party in interest.

The real party in interest is Douglas D. DeMasi, the inventor. He resides at 1214 Beekman Rd.; Hopewell Junction, NY 12533.

(ii) Related Appeals and Interferences.

Prior and pending appeals, interferences or judicial proceedings known to appellant, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal, are

A previous Notice of Appeal, dated March 30, 2007 and filed April 3, 2007, and a Corrected Appeal Brief, dated September 21, 2007, exist in this case in response to a FINAL Office Action mailed 1/9/07 and an Advisory Action mailed 3/12/07.

In partial response to the FINAL Office Action mailed 1/9/07 and the Advisory Action mailed 3/12/07, applicant on April 3, 2007 filed a Petition (dated March 29, 2007) to the Commissioner for Patents in the above-identified application (A) to set aside the action of 1/9/07 as FINAL; (B) to overrule the Examiner's refusal to enter, per the Advisory Action mailed 3/12/07, the amendments proposed in the Amendment After Final dated 2/17/07 and filed 2/20/07; (C) to overrule the Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 fail "to comply with the written description requirement"; and (D) to overrule the Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention".

In a 10/2/07 Decision On Petition, applicant's petition was dismissed. The Special Programs Examiner decided 1) that with respect to issues (A) and (B), the Examiner acted properly; 2) with respect to issues (C) and (D), they are suited for Appeal and as such will not be decided by petition; and 3) that the application be forwarded to the examiner "for further preparation of examiner's answer".

(iii) Status of Claims.

Claims 1- 20 and 43 stand canceled.

Claims 21-42 and 44-51 stand rejected.

Claims 21-42 and 44-51 are being appealed.

(iv) Status of Amendments.

As noted above, the Amendment After Final dated October 23, 2008 and filed October 23, 2008, stands not entered because the Examiner in the Advisory Action mailed 11/6/08 thought that the proposed amendments filed after a final rejection "raise new issues that would require further consideration and/or search; \_\_\_\_\_. The amendment to the claims, specifically claims 21, 28, 34, 38 and 44 raise new issues that would require further consideration and/or search."

As also noted above, the Examiner had refused to enter, per the Advisory Action mailed 3/12/07, the amendments proposed in the Amendment After Final dated 2/17/07 and filed 2/20/07, in response to the FINAL Office Action mailed 1/9/07.

Applicant had sought to amend the Specification in response to the Examiner finally rejecting under 35 USC 112, first paragraph, as failing to comply with the written description requirement, claims 21-33, 38-42 and 44-51: the Examiner alleging that the "claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner had argued that "Regarding claims 21, 28, 38 and 44, the subject matter 'deriving its lift in flight from forces resulting from its motion through air', as now amended, is not supported by the original specification and therefore, now constitute New Matter."

Applicant had proposed amending the Specification to more clearly comply with the written description requirement that "airborne" means "deriving its lift in flight from forces resulting from its motion through air". This definition is consistent with Webster's New Collegiate Dictionary Copyright (C) 1977 by G. C. Merriam Co. definitions for "airborne": "1. supported wholly by aerodynamic forces; 2. transported by air". Thus applicant urged that the invention was described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. Applicant had also urged that other references in the Specification support this interpretation of "airborne". Thus applicant concluded that claims 21-33, 38-42 and 44-51 comply with the written description requirement.

In summary, the Proposed Specification Amendment filed 2/20/07, and the Proposed Claims Amendment filed October 23, 2008, stand not entered.

(v) Summary of Claimed Subject Matter.

Claims 21, 28, 34, and 38 are the independent claims involved in the appeal.

Claim 21 is directed to a rider recreational product having a wing section (wing 12 - Figs. 1, 3, 4 & 5; 2<sup>nd</sup> paragraph, page 7 of Second Substitute Specification) and a fuselage or tail section (surfboard-like fuselage or tail section or portion 14 - Figs. 1, 2, 4 & 5; 2<sup>nd</sup> paragraph, page 7 of Second Substitute Specification) for skimming on water and flying through the air aerodynamically and separable into two sections. The product comprises a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air (last sentence, last paragraph, page 8; sentence beginning in last line on page 10, through last sentence in first full paragraph on page 11). It must be independently usable as a rideable element (paragraph beginning on bottom of page 7 and continuing on page 8). A second section constitutes the fuselage or tail section of the product and is independently usable as a surfboard or ski (surfboard-like fuselage or tail section or portion 14 - Figs. 1, 2, 4 & 5; 2<sup>nd</sup> paragraph, page 7 of Second Substitute Specification; paragraph beginning on bottom of page 9 and continuing on page 10, and the next paragraph).

Claim 28 is directed to a board usable as a fuselage or tail section (fuselage or tail section 14 - Figs. 1, 2, 4, & 5; paragraph beginning on bottom of page 9 and continuing on page 10, and the next paragraph) of a recreational product for skimming on water and flying through the air aerodynamically and usable independently as a surfboard or ski. The board comprises a generally thin and flat elongated portion, a wider rear end on the elongated portion, and thin fins 48 extending upwardly when used as a ski and downwardly when used as a surfboard (Fig. 4; first sentence, last paragraph, page 9) and longitudinally (Fig. 4; second sentence, last paragraph, page 9) from a surface of the

wider rear end and that are upwardly when the board is attached to the recreational product for aiding control when the product is in motion aerodynamically.

Claim 34 is directed to a device comprising a thin, wide body (wing 12 - Figs. 1, 3, 4 & 5; 2<sup>nd</sup> paragraph, page 7 of Second Substitute Specification) usable as an aerodynamically-supporting wing of a waterborne and airborne recreational vehicle and independently as a rideable element. It comprises a central front end portion (central front end 38 - Figs. 1, 3, 4 & 5; 2<sup>nd</sup> paragraph of page 9), a wide rearward portion, and a central rearward portion having a rearward facing opening (rearward facing opening or socket 16 - Fig. 3) for receiving an attachment rendering the body the wing of a recreational vehicle 10 (Figs. 1, 4 & 5).

Claim 38 is directed to a rider recreational product 10 (Fig. 1, 4. & 5) having a wing 12 and a fuselage or tail section 14 for skimming on water and flying through the air aerodynamically (last sentence, last paragraph, page 8; sentence beginning in last line on page 10, through last sentence in first full paragraph on page 11) and separable into two sections. It comprises a first section constituting the wing 12 of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section 14 constituting the fuselage or tail section of the product and independently usable as a surfboard or ski. The first section has longitudinally-extending control fins 34 (Fig. 4; first paragraph on page 9) on its underside for withstanding rugged or slow turns in water and air.

(vi) Grounds of rejection to be reviewed on Appeal.

- A. Whether claims 21-24, 34, 36-38, 40-42, and 44-49 are anticipated by Woolley (US Patent 5,100,354), so as to be properly finally rejected under 35 USC 102(b);
- B. Whether claims 25-33, and 49-51 are unpatentable over Woolley in view of Saghri (US Patent 5,498,184), so as to be properly finally rejected under 35 USC 103(a);
- C. Whether claims 35 and 39 are unpatentable over Woolley in view of Schlueter (US Patent 3,320,625), so as to be properly finally rejected under 35 USC 103(a).

(vii) Argument.

A. Claims 21-24, 34, 36-38, 40-42, and 44-49 are not anticipated by Woolley (US Patent 5,100,354), so as to be properly finally rejected under 35 USC 102(b)!

Claims 21-24, 34, 36-38, 40-42, and 44-49 were finally rejected under 35 USC 102(b) as being anticipated by Woolley (5,100,354). The Examiner stated:

"The device of Woolley reads on the limitations of the claimed invention including: Regarding claims 1 and 38, a wing section (combination 37, 31 and 39) and a fuselage or tail section (13) for on water and flying through the air aerodynamically and separable into two sections (fig. 9--first section and second section--board 13), comprising a first section constituting the wing (fig. 9) of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section (fig. 2 and 5) of the product and independently usable as a surfboard and the first section having longitudinally-extending control fins on its underside (41 and 43). In reference to 'rideable element', it should be noted applicant has not claimed structure to read over the broadest interpretation of a 'rideable element' (i.e., any structure that can support a user). Further, the wing section of Woolley will fly through the air depending on the speed of the boat, the lift against the water and the weight of the user. It should be also noted the second section can be used independently as a surfboard since the board is capable of being disconnected from the wing section as seen in figure 9."

Appellant agrees with the Examiner that "the wing section [flying ski 11] of Woolley will fly through the air depending on the speed of the boat, the lift against the water". But that is not is being claimed. Claim 21, for example, requires "a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air". Woolley's flying ski 11 derives its lift in flight, via strut 29, from the motion of his planing blade 37 through water (col. 10, lines 38 & 39, - "the lifting forces generated on the planning blades by the water can counteract the force of gravity"); Woolley's flying ski 11 does not derive its lift in flight from "forces resulting from its motion through air". Appellant urges that Woolley does not have, in Fig. 9 or elsewhere, a "first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air"; accordingly, the claims are not anticipated by Woolley.

It is apparently true that Woolley'ski 11 will fly through the air not only by being carried by the planning blade 17, but also as a projectile. His ensemble reportedly can be made to jump out of the water (col. 11, lines 23-25). But this flight is by inertial forces, as with projectiles; not by "deriving its lift in flight from forces resulting from its motion through air". Woolley does not disclose a device "deriving its lift in flight from forces resulting from its motion through air".

Thus claims 21-24, 34, 36-38, 40-42, and 44-49 are not anticipated by Woolley (US Patent 5,100,354), and are not properly finally rejected under 35 USC 102(b).

B. Claims 25-33, and 49-51 are not unpatentable over Woolley in view of Saghri (US Patent 5,498,184), and not properly finally rejected under 35 USC 103(a);

Claims 25-33 and 49-51 were finally rejected as being unpatentable over Woolley in view of Saghri (5,498,184). As observed above, Woolley does not teach the fundamentals required by the basic claims. And Saghri does not make up for the deficiencies of Woolley. Thus even is it is obvious to have "the longitudinally extend fins extend downwardly on the board of Woolley", that does not make it obvious to have them extend downwardly on the underside of applicant's wings; hence the claims still distinguish patentably over Woolley in view of Saghri. And there is no evidence that it would be obvious to use the longitudinally extending fins 44 and 48 that Saghri uses on the upper side for enhancing the propulsive capability and stability of his board, on the applicant's wings underside for purposes applicant does: central fin 30 for assuring "even pressure on both sides of the wing-like body 12 when being pulled by a motor boat"; fins 32 and 34 for "control in water, snow and air"; and fins 36 "for added lift and control when getting airborne".

C. Claims 35 and 39 are not unpatentable over Woolley in view of Schlueter (US Patent 3,320,625), and are not properly finally rejected under 35 USC 103(a).

Claims 35 and 39 were rejected as being unpatentable over Woolley in view of Schlueter (3,320,625), the Examiner alleging that "Woolley teaches most of the elements of the claimed invention ...". Claims 35 and 39 are dependent claims, and as noted above, Woolley does not teach all of the elements of the claimed invention. Thus dependent

claims 35 and 39 are patentable, not only for their additional limitations, but also for the limitations recited in the basic claims.

Appellant believes that he is the first one to invent a rider-disassemblable recreational product having a wing section and a fuselage or tail section for skimming on water and flying through the air aerodynamically, that is separable into two sections comprising a first section constituting the wing of the product and deriving its lift in flight from the reaction forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski. The claims reflect different aspects of the new invention..

(viii) Claims Appendix

(ix) Evidence Appendix

(x) Related Proceedings Appendix

Respectfully submitted,

  
Joseph B. Taphorn

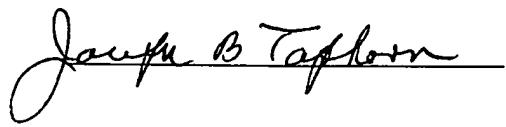
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Attachment – Check

CERTIFICATE OF MAILING - The undersigned certifies that this correspondence addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop Appeal Brief - Patents; has been deposited in the United States Postal System as first class mail with sufficient postage on January 24, 2009.

  
Joseph B. Taphorn

(viii) Claims Appendix

**Claim 21:** A rider recreational product having a wing section and a fuselage or tail section for skimming on water and flying through the air aerodynamically and separable into two sections, comprising a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski.

**Claim 22:** A recreational product according to claim 21, wherein the wing section has control elements on its upper surface for engagement by the rider.

**Claim 23:** A recreational product according to claim 21, wherein the tail section has control elements on its upper surface for engagement by the rider.

**Claim 24:** A recreational product according to claim 21, wherein the wing section has longitudinally extending fins on its underside for facilitating control of the product when in motion.

**Claim 25:** A recreational product according to claim 21 wherein the tail section has longitudinally extending fins on its upper side for facilitating control of the product when in motion.

**Claim 26:** A recreational product according to claim 24, wherein the tail section has longitudinally extending fins on its upper side for facilitating control of the product when in motion.

**Claim 27:** A recreational product according to claim 26, wherein both the wing section and the tail section also have control elements on their upper surfaces for engagement by the rider.

Claim 28: A board usable as a fuselage or tail section of a recreational product for skimming on water and flying through the air aerodynamically and usable independently as a surfboard or ski, comprising a generally thin and flat elongated portion, a wider rear end on the elongated portion, and thin fins extending upwardly when used as a ski and downwardly when used as a surfboard and longitudinally from a surface of the wider rear end and that are upwardly when the board is attached to the recreational product for aiding control when the product is in motion aerodynamically.

Claim 29: A board according to claim 28, wherein the surface that is upwardly when the board is attached to the recreational product has control elements on its upper surface for engagement by the rider.

Claim 30: A board according to claim 28, wherein the surface that is upwardly when the board is attached to the recreational product is of a non-slip material.

Claim 31: A board according to claim 29, wherein the surface that is upwardly when the board is attached to the recreational product is of a non-slip material.

Claim 32: A board according to claim 29, wherein the surface that is upwardly when the board is attached to the recreational product has control elements for engagement by the rider to control the product when it is in motion.

Claim 33: A board according to claim 29, wherein the board is constituted of upper and lower layers separated by an inflatable bladder.

Claim 34: A device comprising a thin, wide body usable as an aerodynamically-supporting wing of a waterborne and airborne recreational vehicle and independently as a rideable element, comprising a central front end portion, a wide rearward portion, and a central rearward portion having a rearward facing opening for receiving an attachment rendering the body the wing of a recreational vehicle.

Claim 35: A device according to claim 34, and a tow hook secured to the central front end portion.

Claim 36: A device according to claim 34, and fins that extend longitudinally on its underside.

Claim 37: A device according to claim 34, wherein the body is constituted of upper and lower layers separated by an inflatable bladder, and the upper layer has a non-slick upper surface and bears elements for engagement by the rider to control the body when it is in motion.

Claim 38: A rider recreational product having a wing and a fuselage or tail section for skimming on water and flying through the air aerodynamically and separable into two sections, comprising a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air and independently usable as a rideable element, and a second section constituting the fuselage or tail section of the product and independently usable as a surfboard or ski, the first section having longitudinally-extending control fins on its underside for withstanding rugged or slow turns in water and air.

Claim 39: A rider recreational product for skimming on water and flying through the air and separable into two sections according to claim 38, wherein the first section has a front end, and a tow hook secured to the front end of the first section.

Claim 40: A rider recreational product for skimming on water and flying through the air and separable into two sections according to claim 38, wherein both the wing section and the tail section have control elements on their upper surfaces for engagement by the rider.

Claim 41: A rider recreational product for skimming on water and flying through air and separable into two sections according to claim 38, wherein there is a central longitudinal fin to insure even pressure throughout the first section when in motion.

Claim 42: A rider recreational product for skimming on water and flying through air and separable into two sections according to claim 41, wherein there are longitudinally-extending fins at the outer edges of the first section for added lift and control.

Claim 44: A rider recreational product having wings for skimming on water and flying through air aerodynamically comprising first parts constituting the wings of the product and deriving its lift in flight from forces resulting from its motion through air and engaging the water during skimming on water.

Claim 45: A rider recreational product for skimming on water and flying through air according to claim 44, said product also having a fuselage or tail section, and a second part constituting the fuselage or tail section of the product and engaging the water during skimming on water.

Claim 46: A rider recreational product for skimming on water and flying through air according to claim 44, wherein the first parts constituting the wings of the product and engaging the water during skimming on water have control elements on their upper surfaces for engagement by the rider.

Claim 47: A rider recreational product for skimming on water and flying through air according to claim 45, wherein the second part constituting the fuselage or tail section of the product and that engages the water during skimming on water has control elements on its upper surface for engagement by the rider.

Claim 48: A rider recreational product for skimming on water and flying through air according to claim 44, wherein the first parts constituting the wings of the product and engaging the water during skimming on water have longitudinally extending fins on their undersides for facilitating control of the product when in motion.

Claim 49: A rider recreational product for skimming on water and flying through air according to claim 45, wherein the second part constituting the fuselage or tail section of the product and that engages the water during skimming on water has longitudinally extending fins on its upperside for facilitating control of the product when in motion.

Claim 50: A rider recreational product for skimming on water and flying through air according to claim 48, wherein the second part constituting the fuselage or tail section of the product and that engages the water during skimming on water has longitudinally extending fins on its underside for facilitating control of the product when in motion.

Claim 51: A rider recreational product for skimming on water and flying through air according to claim 50, wherein both the first parts constituting the wings of the product and engaging the water during skimming on water and the second part constituting the fuselage or tail section of the product the wing of the product and engaging the water during skimming on water have control elements on their upper surfaces for engagement by the rider in prone, sitting, kneeling and standing positions.

(ix) Evidence Appendix

Appellant is unaware of any evidence submitted pursuant to sections 1.130, 1.131, or 1.132 of 37 CFR or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

(x) Related Proceedings Appendix

Appellant is unaware of any decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(10)(ii) of 37 CFR 41.37, other than the Petition identified above. In the 10/2/07 Decision On Petition, appellant's petition was dismissed. The Special Programs Examiner decided 1) that with respect to issues (A) and (B), the Examiner acted properly; 2) with respect to issues (C) and (D), they are suited for Appeal and as such will not be decided by petition; and 3) that the application be forwarded to the examiner "for further preparation of examiner's answer". Thus, the 10/2/07 Decision On Petition sustained the Examiner's action of 1/9/07 as FINAL (A), and the Examiner's refusal to enter, per the Advisory Action mailed 3/12/07, the amendments proposed in the Amendment After Final dated 2/17/07 and filed 2/20/076 (B); and declined to review Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 fail "to comply with the written description requirement" (C); and the Examiner's rejection under 35 USC 112, first paragraph, in the 1/9/07 Action that claims 21-33, 38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (D).

The 10/2/07 Decision On Petition also ordered that the application be forwarded to the examiner "for further preparation of examiner's answer".

The Examiner responded to the Decision On Petition with the new and FINAL rejection mailed 12/28/07 and being appealed from.

A copy of the 10/2/07 Decision On Petition is attached hereto.

Attachment



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents  
United States Patent and Trademark Office  
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10/2/07

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*In re* Application of:  
Demasi, Douglas, D.  
Serial No.: 09/845,999  
Filed: Sept. 24, 2001  
Docket: None  
Title: UNIVERSAL FLYING HAWK

DECISION ON PETITION

This is a decision on the petition filed on Apr. 3, 2007 seeking to withdraw the finality of the Office action. This petition is being considered pursuant to 37 C.F.R. §1.181. There is no fee for this petition.

The petition is **DISMISSED**.

In the petition, the petitioner requests the following relief:

- (A) to set aside the final rejection from January 9, 2007;
- (B) to reverse the Examiner's refusal to enter Amendment After Final filed on February 20, 2007;
- (C) to reverse the Examiner's 35 U.S.C. §112, first paragraph rejection of claims 21-33, 38-42 and 44-51 for failure "to comply with the written description requirement"; and
- (D) to reverse the Examiner's rejection under 35 U.S.C. §112, first paragraph, that claims 21-33, 38-42 and 44-51 are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

On Feb. 20, 2007, the applicant proposed an amendment to the specification after final rejection was issued in order to distinguish the applicant's invention from prior art and thereby overcome the examiner's rejection. The examiner deemed the proposed amendment after final as containing matter not supported by the original application, and as such, the proposed amendment to the specification was not entered. Petitioner believes there is no issue of new matter involved in the rejected claims under the final rejection, and that no new search is required under M.P.E.P. § 707.07(g). Petitioner also contends that no new matter was raised and no need for further search that the rejected claims under the final rejection should be withdrawn and found allowable.

The record shows that:

- 1) On Oct. 18, 2006 the applicant responded to the examiner's first office action with an amendment.
- 2) On Jan. 9, 2007, the examiner issued a final rejection necessitated by the applicant's amendment.
- 3) On Feb. 20, 2007 the applicant filed an amendment after final stating the final was premature due to no clear issues have been reached and the new grounds of rejection were not necessitated by the amendment filed 10/18/06.
- 4) On Mar. 12, 2007, the examiner issued an advisory action stating that the proposed after final amendment to the specification of Feb. 20, 2007 was not entered because they raised new issues for consideration and search as well as raising new matter.
- 5) On Apr 3, 2007, the petitioner filed both the present petition and a notice of appeal.
- 6) On May 27, 2007, the petitioner filed an appeal brief in triplicate.

#### Discussion and Analysis

With regard to the requested Relief A, a determination as to if amendment filed on Oct. 18, 2006 necessitated the new grounds of rejection in the final Office action of Jan. 9, 2007 must be made by making a comparison of the amended claims 21, 28, 34-39, 44 and 45 filed on Oct. 18, 2006 and the previous corresponding claims of Jul. 5, 2006. In the non-final Office action of Sep. 26, 2006, the examiner applied prior art U.S. patents to Goudy (US Patent 3,650,234), Skaszynski (US Patent 1,099,575) and Schlueter (US Patent 3,320,625) in the rejection of claims 21-32, 34-36, 38-42 and 44-51. However, the applicant's amendment to the claims 21, 28, 34-39 and 44-45 filed on Oct. 18, 2006 added limitations regarding "flying through the air aerodynamically and separable into two sections, comprising a first section constituting the wing of the product and deriving its lift in flight from forces resulting from its motion through air" which necessitated the new grounds of rejection in applying new prior art references to Zistl (DE4332216A), Clayton (US Patent 4,898,345) and Rock (US Patent 5,152,705) in the final rejection of claims 21-32, 34-36, 38-42 and 44-51. These newly added limitations were not claimed previously. This is a clear indication that the applicant's amendment of Oct. 18, 2006 responding to the first office action of Sep. 26, 2006 necessitated the new grounds of rejection in the final Office action mailed Jan. 9, 2007. The petitioner also contends that the final office action was premature because a clear issue had not been reached. This however, is incorrect because the final rejection was properly issued in accordance with MPEP § 706.07(a)<sup>1</sup>.

With regard to the requested Relief B, the petitioner asserts that since the final was improper, the petitioner has a right to have the amendments after final entered. However, the record clearly indicates the final rejection was proper. Entry of amendments after final rejection is not a matter of right (see 37 CFR § 1.116). The review of the record shows that the examiner was in

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<sup>1</sup> The M.P.E.P. § 706.07(a) states that: "the second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)."

compliance with proper examining practice as set forth in MPEP 714.13 in refusing entry of the after final amendment submitted Feb. 20, 2007. The examiner indicated in the advisory action of Mar. 12, 2007, the amendment to the specification contains issues of new matter which is an appealable issue. The examiner did not abuse his discretion or act in an arbitrary or capricious manner in denying entry of the proposed claims after final for the reasons stated. Therefore there is no basis for granting the relief requested.

With regard to the requested Relief C and D, petitioner requests that the rejection of claims under 35 USC § 112 be reversed. Petitioner argues that the meaning of the phrase "deriving its lift in flight from forces resulting from its motion through air" is inherent in the phrase "kept airborne" and therefore, it does not constitute new matter. The meaning is also consistent with the rest of the specification and with the drawings and definitions in dictionaries. However, by applying the plain language of 37 CFR 1.181(a)(1)<sup>2</sup>, it is clear that the petitioner's arguments will not support the requested relief, because the relief requested is simply not the type of relief that can be obtained by petition. The issues presented by the petitioner are clearly directed to the propriety of the examiner's rejection of the claims under 35 U.S.C. 112 1<sup>st</sup> paragraph. The question of whether or not the claims should be rejected under 35 U.S.C. § 112 is an issue suited for appeal. As such, it will not be decided by petition.

### Conclusion

Based on the forgoing reasons the requested relief cannot be granted. The application is forwarded to the examiner in Art Unit 3714 for further preparation of examiner's answer.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED

*Karen M. Young*  
for Frederick R. Schmidt, Director  
Technology Center 3700

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<sup>2</sup> 37 C.F.R. § 1.181(a)(1) states: "Petition may be taken to the Director: From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination preceding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court." [emphasis added]